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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,196	01/11/2000	PAUL MATTHEW PIRILLO	8461	5306

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PAUL W MARTIN
NCR CORPORATION
LAW DEPARTMENT
101 W SCHANTZ AVENUE
DAYTON, OH 45479

EXAMINER

CHANG, SABRINA A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,196

Applicant(s)

PIRILLO, PAUL MATTHEW

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,13-17 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,13-17 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendments to claims 1, 10 and 18 and cancellation of claims 3, 4, 11, 12, 19 and 20 – Paper 7, 7/2/2003 - have been considered.

Response to Arguments

Applicant's arguments filed 7/2/2003 have been fully considered but they are not persuasive.

Applicant asserts that Heutschi does not include the ability to launch customer-specific commerce or marketing initiatives. Specifically, applicant states that the system of Heutschi is unable to identify the customer and their past purchasing habits, preferences, loyalty programs, etc.

Examiner respectfully draws attention to Figure 9 and Col 5, Line 9. Heutschi generally discloses generally an electronic device that is capable of downloading digital media, such as books [Abstract]. In a specific embodiment the device serves as a way of purchasing electronic goods. The goods are targeted to the shopping habits of the user.

The concept of customer relationship management is a well-established business principle. This is accomplished using any number of marketing or advertising techniques including storage of customer information for future lead generation, easier product selection or guided shopping. In that Heutschi encompasses targeted marketing functionality, it is inherent that it has the capability to store and “remember” the individual customers and their habits in order to facilitate more efficient and successful future purchases.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heutschi U.S. Patent No. 6,335,678.

Heutschi discloses a system comprising a mobile electronic device (customer contact device) and a data transmitting station or kiosk (self-service terminal, data interface) that serves as a central location for downloading information and media onto the mobile device.

The kiosk consists of a screen with a touch-screen sensor and a driver for the visual output or control of a connection to the Internet and of an interface to the electronic book (data transfer interface for acquiring and transferring data from the device) [Col 3, Line 57]. The kiosk is connected to a central system, via the Internet, that maintains the “accounting” of all electronic media, financial transactions and user information [Fig. 1].

Heutschi discloses that the electronic device also has an incorporated touch-screen sensor for controlling operation as well as a microphone [Col 4, Line 15]. The device also can be equipped with a loudspeaker, a microphone and a video camera making it possible to hold videoconferences with one or more participants by way of telephone, television or radio connection [Col 2, Line 36].

A user can take their device to a “bookstore” where they can download their choice of books and documents from a data transmission center [Col 4, Line 60. Figure 5]. The relevant information and data will be charged to the customer/reader – clearing [Col 2, Line 66]. Further,

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Heutschi discloses an electronic shopping catalog (generating customer selectable options based on the received customer information) that can be transmitted to the electronic device, targeted on the requirements and shopping habits of the user – inherently comprising the identification of the user (receiving customer information, based on customer preferences and purchase and usage patterns, generating customer information display, or advertisements) [Col 5, Line 9. Fig, 9].

The electronic device may communicate and exchange data by way of integrated interfaces with peripherals such as a PC (cradle is adapted to read information from electronic book) [Col 5, Line 60]. Transmission of data from the data transmission center can occur by cable, infra-red light beam or radio network [Col 1, Line 60]. The electronic media can be encrypted such that only specific users will be able to access downloaded information. The book data loaded and stored on the device can only be opened and read with the personal PIN code of the SIM card on the device (cryptographic process) [Col 3, Line 5].

In reference to claims 21 Heutschi does not explicitly disclose the use of JAVA for the retrieval of the advertisements. However, in that the system could use any number of programming methods to present the advertisements/catalogs/promotions to the user, the use of JAVA is not patently distinguishable. JAVA has various benefits, including enhanced multimedia functionality as well as faster delivery. The use JAVA or any other more efficient means of programming to present its advertisements/promotions to the user does not have an unpredictable result.

Heutschi does not explicitly disclose that the customer information interface includes a smart card reading/writing device. However applicant describes that the use of the electronic book is interchangeable with a smart card reader for identifying a customer and supplying

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customer information [Page 7]. In that the identification of each unique customer could occur using any number of methods known in the art, whether using the electronic book device itself or otherwise, the use of a smart card to identify a user does not lend to an improvement in the system or have an unpredictable result.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heutschi U.S. Patent No. 6,335,678 in view of the system of Ceberus as described in the article "The virtual record co" (McManus, Sean. July 10, 1999. Melody Maker)

Heutchi does not explicitly disclose that the data transfer interface includes a CD recorder for recording software on a disk. Heutchi provides the basic method for identification of a customer and payment for purchasing digital media, the media could be transferred by any number of means, whether directly to the electronic device itself or to another write-able medium.

The article teaches a media distribution system, Ceberus. Customers can choose a compilation of songs or media that they'd like to purchase on a kiosk where the kiosk then writes the compilation to the CD immediately for more efficient delivery of a desired digital media product.

It would have been obvious to modify the system of Heutchi to include the ability to download the purchased digital media to any number of write-able mediums, including a CD as taught by Ceberus, in order to provide the customer with the greatest number of options for purchasing and obtaining a digital media product.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chombo U.S. Patent No. 6,313,828 discloses an electronic book comprising an electronic book. Chombo does not disclose a system or method for downloading data to the electronic book.

Sachs et al. U.S. Patent No. 5,96,034 discloses an electronic publication publishing and distribution system using electronic books. Sachs et al. does not disclose the download of electronic media onto the book in a kiosk-type environment.

Shwartz et al. U.S. Patent No. 5,902,516 discloses a method for controlling a screen display of an electronic book. Shwartz et al. does not explicitly disclose a system for downloading new media to an e-book.

Reavey et al. U.S. Patent No. 5,847,698 discloses an electronic book device. Reavey et al. does not explicitly disclose a method or system for downloading new media to the e-book.

Gaston U.S. Patent No. 5,956,048 discloses an electronic book system where the e-book can dock in a stationary "stand" for downloading new media and recharging. The system does not disclose the purchase of the data or the identification of the customer.

Tognazzini U.S. Patent No 6,825,482 discloses a newspaper vending machine is equipped with a computerized control and an infrared communications transceiver. The system does not disclose the ability to identify the user and target specific content at them.

Munyan U.S. Patent No. 5,761,485 discloses an electronic book system. The system does not disclose a user going to a kiosk to download new media.

Saito U.S. Patent No. 6,128,605 discloses a data copyright management apparatus for handling digital rights. The system does not explicitly disclose an e-book purchasing/downloading system.

Yoshimune U.S. Patent No 6,438,233 discloses a book data service system in which the book data can be delivered by broadcasting. The system does not disclose the purchasing/downloading of an e-book at a specific site.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 7687 for regular communications and 703 305 7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600